

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Number : 09/728,340 Confirmation No.: 5053
Applicant : Vicknair, Tom
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Title : ELECTRONIC CHECK PRESENTMENT SYSTEM AND
METHOD HAVING AN ITEM SEQUENCE CAPABILITY
TC/Art Unit : 3693
Examiner: Dass, Harish T.

Docket No. : J72167.X00253
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REQUEST FOR PRE-APPEAL BRIEF CONFERENCE

Pursuant to the Pre-Appeal Brief Conference Pilot Program announced in the Official Gazette, Applicants hereby request a pre-appeal brief conference in the above-referenced case. With the publication of the PTO's new rules on RCEs that will result in more appeals, Applicant respectfully submits that the Pre-Appeal Conference Panel now has an even more important role in preventing unsupportable rejections like this one from proceeding to the Board.

The present invention relates, generally, to a system and method for Electronic Check Presentment (ECP) processing that digitally images physical checks as they arrive subsequent to posting of ECP items. In brief, according to an exemplary embodiment, the transmitting bank 10 generates the ECP file 15 and transmits the ECP file 15 to the drawee bank 20. The drawee bank 20 performs ECP processing 25 and generates the item database 35 that contains all the information with respect to each ECP item, including a unique ISN number. [0029] The paper items 40 arrive at a later time. The images 110 are electronically linked to the data records that

represent the checks. Sorters used in the capture process can generate a new ISN, which can be disregarded once the internal processes of the capture processes 110 are completed. [0034] During the proofing process at 120, in which the data records for the ECP items 15 are validated against the data records for the physical items 40, the records are updated such that the posting date and ISN number for the data records for the physical items reflect the posting date and ISN number of the ECP items. [0035] As the digital image of the check is electronically linked to the data records, the image thus carries the posting date and ISN of the ECP item. [0040].

After the Final Office Action dated July 24, 2007 (“Final-Office Action”), claims 1-6, 8-10, 36-41 and 43-45 stand rejected under 35 U.S.C. § 103(a), as allegedly obvious over Geer (U.S. Patent No. 5,930,778) in view of Gruenwald (U.S. Patent No. 6,457,006). Applicant respectfully submits that the rejection of claims 1-6, 8-10, 36-41 and 43-45 includes errors in fact and omits essential elements of a *prima facie* rejection.

Applicant respectfully submits that Geer fails to teach or fairly suggest, “receiving the paper-based banking transactions after having received the ECP file”, as recited in claim 1. The Examiner cites column 5, lines 10-45 of Greer, and relies on the language “Another embodiment of the... sends the paper check after...”. *See* Final Office Action at pg. 7. However, Greer teaches that the “paper checks [are sent] after processing at the point of receipt from the payee’s location into the check clearing and collection system”. *See* Greer, col. 5, lines 10-15. Greer is silent as to when the paper financial instruments are received, and therefore does not teach or fairly suggest “receiving the paper-based banking transactions after having received the ECP file”, as recited in claim 1.

The Examiner also asserts that, “Applicant has not presented any evidence that paper checks do not follow the ECP.” See Final-Office Action, at pg. 7. Applicant respectfully submits that the Examiner is committing legal error. It is the Examiner’s burden to show by a preponderance of the evidence that Geer teaches or fairly suggests all the elements and limitations of independent claim 1, not Applicant’s. See M.P.E.P. § 2142 (“To establish a *prima facie* case of obviousness... the prior art reference (or references when combined) must teach or suggest all the claim limitations” (emphasis added)).

Applicant further submits that Geer does not teach or suggest, “*correlating the first and second records*”, as recited in claim 1. The Examiner cites col. 10, lines 50-57, which states that “electronic transfer and processing of payments occur and paper checks follow at some later time for confirmation, reconciliation and storage by the payor bank”, and then asserts that “Reconciliation of paper check and ECP is done only when the paper check and ECP entry is correlated otherwise payment cannot be reconciled”. See Final Office Action at pg. 6.

First, Applicant respectfully submits that on page 2 of the Final Office Action the Examiner asserts that the data collected during first scanning (MICR, amount of the check and date) corresponds to the claimed “first record”, and on page 3 of the Final Office Action the Examiner asserts that “visually perceptible image of the financial instruments” corresponds to the claimed “second record”. However, in asserting that Geer teaches “*correlating the first and second records*”, as recited in claim 1, the Examiner cites a portion of the reference that teaches reconciling paper checks and the ECP. Therefore, the Examiner does not appear to be consistently interpreting the claims or the Geer reference.

Second, Greer does not define the term “reconciling”, although in accounting, “reconciling” usually means reconciling accounts with the financial books. Thus, to the extent that the Examiner is asserting that reconciled paper checks and ECPs are inherently correlated, Applicant respectfully disagrees. An element is only inherently disclosed if it is *necessarily* present, the fact that an element *may* be present is not sufficient to establish inherency. See *In re Rijchaert*, 28 U.S.P.Q.2d 1955, 1957 (Fed. Cir. 1993). In order to establish inherency, extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the reference and that persons of ordinary skill would so recognize. See *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999). Here, the Examiner offers no evidence, or even reasoning, why correlating is inherent within reconciling. Further, Geer provides no definition of “reconciling”, and it is not clear why (or how) paper checks and ECPs may actually be correlated.

Applicant further submits that the references, as relied upon by the Examiner, do not teach or fairly suggest “*wherein the second records and the digital images are linked to the first records by the first item sequence number.*” In fact, the Examiner does not address this unique feature of claim 1. In as much as the Examiner failed to address a feature of claim 1, the Examiner did not meet the burden in establishing a *prima facie* case of obviousness, because the Examiner did not address each and every feature and limitation of the claim. See M.P.E.P. § 2142.

In addition, it is noted that to the extent that the Examiner is combining features of embodiments of Geer, different embodiments may not be combined absent a specific teaching to do so. See *In re Kramer*, 18 USPQ2d 1415, 1416 (Fed. Cir. 1991); *Ex parte Beuther*, 71 USPQ2d 1313, 1316 (BPAI 2003).

Applicant respectfully submits that Gruenwald fails to compensate for the deficiencies of Geer.

Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of claims 1-6, 8-10, 36-41 and 43-45 under 35 U.S.C. § 103(a), because Geer and Gruenwald, alone or in combination, do not teach or fairly suggest all of the features and limitations of the claims.

Applicant respectfully requests that the Office issue a Panel Decision allowing the application based on existing claims and closing the prosecution record.

Respectfully submitted,

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